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REMARKS

Claims 2-5, 7-8, 10-14, 20-28, 35-38, 40-41, 43-47, 53-58, 68-71, 73-74, and 76-80 and 86-88 are pending in the application. Applicant respectfully requests reconsideration in view of the Remarks submitted herewith.

Claims 2-5, 7-8, 11-14, 20-28, 35-38, 40-41, 44-47, 53-58, 68-71, 73-74, 77-80 and 86-87 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leak et al. (US 6,182,072 B1) ("Leak") in view of Chen et al. (US 6,625,624 B1) ("Chen"). For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference of combine references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicant respectfully submits that the combination of references suggested by the Examiner does not teach or suggest the limitation "a method for providing resources from a Web server to a client computer, the method comprising: receiving a single request from a client computer, the single request identifying a desired Web page; generating a site map including the desired Web page; ... and sending an archive file containing the site map to the client computer in response to the single request," as recited in Claim 11.

Leak is directed to making web browsing more like watching television by allowing a user to view a sequence, or tour, of web pages without having to specifically locate or request each individual web page. Applicant disagrees with the Examiner that the sections referred to by the Examiner (col. 3, lines 56-67, col. 4, line 1 to col. 4, line 44, col. 6, lines 27 to col. 7, line 31, Fig. 8) teach "a method for providing resources from a Web server to a client computer, the method comprising: receiving a single request from a client computer, the single request identifying a desired Web page; generating a site map including the desired Web page," as recited in Claim 11.

The sections of Leak referred to by the Examiner teach creating a tour of web pages displayed on a client system without requiring the user to locate or request each

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page. The tour may be generated from a currently downloaded web page, from a hit list obtained using a traditional web search engine or it may be generated by the server system. When the tour is generated from a currently downloaded web page, the client system individually requests each web page based on the URLs associated with the web page. This is not the same as "generating a site map" from a "single request from a client computer" as recited in Claim 11. Similarly, Leak teaches that when the tour is generated from a hit list obtained using a traditional web search engine that the web page is downloaded to the client system and then the client system individually requests each web page based on their URLs. Again, this is not the same as "generating a site map" from a "single request from a client computer" as recited in Claim 11. Leak also teaches that the tour may be generated by the server system. In this case, the client system receives the web pages automatically and not in response to a request from the client server. This is not the same as "generating a site map" from a "single request from a client computer" as recited in Claim 11. For at least these reasons, Claim 11 is patentable over Leak in view of Chen.

Further, the Examiner has stated that col. 6, line 27 to col. 7 line 31 and FIG. 8 teach "generating a site map including the desired Web page" as recited in Claim 11. Applicant respectfully disagrees, as the sections referred to by the Examiner teach the general structure and layout of HTML documents and Web pages with no mention of "generating a site map including the desired Web page" as recited in Claim 11. For at least these reasons, Claim 11 is patentable over Leak in view of Chen.

The Examiner has also stated that Leak does not teach "sending an archive file containing the site map to the client computer in response to the single request," as recited in Claim 11. The Examiner suggests that this limitation is taught by Chen. Chen is directed to archiving services that allow users to retrieve and/or search for old information, even after such information has evolved or disappeared from the original server. Chen does not cure the deficiencies stated above in reference to Claim 11 and therefore for at least the reasons advanced above, Claim 11 is patentable over Leak in view of Chen.

Even if Chen cured these deficiencies, there would be no motivation to combine Leak and Chen in the manner suggested by the Examiner. Applicant respectfully submits

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that the Examiner cannot establish obviousness by locating references which describe various aspects of a patent Applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent Applicant has done. *Ex parte Levengood*, 28, USPQ2d 1300, 1302 (Bd.Pat.App.Int., 1993). References may not be combined indiscriminately. It is not enough for a valid rejection to view the prior art in retrospect once an Applicant's disclosure is known. The art applied should be viewed by itself to see if it fairly disclosed doing what an Applicant has done. *In re Skoll*, 187 USPQ 481, 484 (CCPA, 1975) (citing *In re Schaffer*, 108 USPQ 326, 328-29 (CCPA, 1956)). "The test for an implicit showing [of obviousness] is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved *as a whole* would have suggested to those of ordinary skill in the art." (Emphasis added). *In re Kotzab*, 217 F.3d 13645, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Examiner suggests that it would have been obvious to one skilled in the art to combine Leak and Chen to "enable users to retrieve and search through old information, even after such information has evolved or disappeared from the original server." Chen teaches archiving services, but does not teach/disclose a displayable tour, or sequence, of web pages. Neither Leak nor Chen, either singly or in combination, appear to be concerned with, or recognize the advantages of, an archiving service for displaying a tour, or sequence of web pages on a client machine. Applicant traverses the Examiner's suggestion that Leak contains any suggestion that searching through old information would be desirable for creating a displayable tour of web pages. Leak teaches a displayable tour, or sequence, of web pages, but does not teach/disclose an archiving service. In arriving at an absence of any teaching to combine the References, one skilled in the art does not arrive at the claimed invention. In view of the foregoing, Applicant submits that no motivation can be found in either of the References to combine the technologies of the References to arrive at the claimed invention, and that the Examiner has improperly combined the References since there is no evidence of a motivating force which would impel one skilled in the art to do what the patent Applicant has done. Accordingly, Applicant respectfully requests reconsideration and withdrawal of these rejections.

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For at least the above reasons, Claim 11 is patentable over Leak in view of Chen. Because they depend from Claim 11, Claims 2-5, 7-8, 10, 12-14, 20-25 and 86 are patentable for the same reasons that Claim 11 is patentable. Because they contain similar limitations, Claims 26, 44 and 77 are patentable over Leak in view of Chen for the same reasons advanced above for Claim 11. In addition, because they depend from Claim 26, Claims 27-28 are also patentable. Because they depend from Claim 44, Claims 35-38, 40-41, 43, 45-47, 53-58 and 87 are patentable for the same reasons that Claim 44 is patentable. Because they depend from Claim 77, Claims 68-71, 73-74, 76-80 and 88 are patentable for the same reasons that Claim 77 is patentable.

In view of the foregoing remarks, Applicant submits that the above-identified application is now in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance be issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 06-1130, maintained by Applicant's attorneys.

Respectfully submitted,

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